

REMARKS

The present Application is a continuation of U.S. Application Serial No. 10/244,083, filed September 12, 2002 by Joseph A. Zupanick, and entitled "Three-Dimensional Well System for Accessing Subterranean Zones" (hereinafter the "Parent Application"). This continuation Application contains claims which are generally similar to the claims which were pending in the Parent Application at the time the Examiner in that case issued an Office Action mailed December 31, 2003. The correlation of the claims is as follows:

- Claims 1 and 15 of the present application contain similar, although not identical, limitations to Claims 1 and 16 of the Parent Application at the time of the December 31, 2003 Office Action. Claims 1 and 15 also recite additional limitations not recited in Claims 1 and 16 of the Parent Application.
- Claims 2-10 and 16-24 of the present application generally correspond to Claims 2-10 and 17-25 of the Parent Application at the time of the December 31, 2003 Office Action.
- Claims 11 and 25 of the present application contain similar, although not identical, limitations to Claims 12 and 27 of the Parent Application at the time of the December 31, 2003 Office Action.
- Claims 12-14 and 26 of the present application generally correspond to Claims 13-15 and 28 of the Parent Application at the time of the December 31, 2003 Office Action.

For the reasons discussed below, Applicant respectfully submits that the claims of the present application are patentable in light of the references cited in the December 31, 2003 Office Action for the Parent Application.

Examiner's Rejection of the Claims of the Parent Application

In the December 31, 2003 Office Action with respect to the Parent Application, the Examiner rejected Claims 1, 3-4, 10-11, 13-16, 18-19, 25-26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,941,308 issued to Malone, et al. ("*Malone*") in view of U.S. Patent No. 5,853,224 issued to Riese ("*Riese*"). Furthermore, the Examiner rejected Claims 2, 5, 7-9, 12, 17, 20, 22-24, and 27 under U.S.C. § 103(a) as being unpatentable over *Malone* in view *Riese* and further in view of Published U.S. Patent Application 2002/0108746 filed by Zupanick, et al. ("*Zupanick*").

Malone discloses a multi-lateral well system that segregates and prevents co-mingling of production fluids flowing from a plurality of lateral well bores that extend outward from a main well bore. (*Malone*, Abstract, Col. 3; Lines 30-45). The well bores may extend horizontally out into the target formation. (*Malone*, Col. 5; Lines 65-66). A solid segregator body with openings for each well lateral well bore is positioned in the main well bore to align the bores and angularly offset each bore by 120 degrees. (*Malone*, Col. 3; Lines 64-66, Figures 2 and 3).

Riese discloses a method for completing a well in a coal formation by perforating the coal formation using a perforating gun and producing fluids and particulate coal through the well. (*Riese*, Abstract, Col. 2; Lines 30-37). In the event that a main well is abandoned, a sidetracked well may be drilled adjacent to the abandoned main well. (*Riese*, Col. 5; Lines 1-4, FIGURE 6).

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. For the reasons discussed below, Claims 1-26 are allowable because over *Malone*, *Riese*, and *Zupanick*, whether consider alone or in combination.

Present Claims 1 and 15 are Allowable Over *Malone* in view of *Riese*

Claim 1 of the present application recites the following:

A method for accessing a plurality of subterranean zones from the surface, comprising:

forming an entry well from the surface; and

forming two or more exterior drainage wells from the entry well through the subterranean zones, wherein the exterior drainage wells each extend outwardly and downwardly from the entry well for a first distance and then extend downwardly for a second distance, such that each exterior drainage well passes through a plurality of the subterranean zones and is operable to drain fluid from the plurality of the subterranean zones.

Claim 15 recites similar, although not identical, limitations.

A *prima facie* case of obviousness cannot be maintained with respect to present Claims 1 and 15 for at least two reasons. First, present Claims 1 and 15 recite limitations not disclosed in *Malone* or *Riese*, whether considered alone or in combination. Claim 1, recites, in part, that each exterior drainage well passes through a plurality of the subterranean zones and is operable to drain fluid from the plurality of the subterranean zones. Claim 15 recites similar, although not identical, limitations. Neither *Malone* nor *Riese* disclose this limitation. Rather, *Malone* and *Riese* merely disclose that their well bores extend into, and may remove material from, a given zone for each well bore. (*Malone*, FIGURE 1, Col. 3; Lines 30-48; *Riese*, FIGURE 6, Col. 4; Line 64 – Col. 5; Line 4)

Furthermore, a *prima facie* case of obviousness cannot be maintained with respect to present Claims 1 and 15 because, in the December 31, 2003 Office Action for the Parent Application, the Examiner did not show the required suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine the cited references. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01. Thus, the

mere fact that the teachings of *Riese* would improve the teachings of *Malone*, as the Examiner asserts in the December 31, 2003 Office Action for the Parent Application, does not provide the required suggestion to combine. Nothing in *Malone*, *Riese*, or any other cited reference suggests or motivates the proposed combination, nor did the Examiner provided evidence that suggests the proposed combination. If “common knowledge” or “well known” art was relied on to combine the references, Applicant respectfully requests that the Examiner provide a reference in support of this position pursuant to M.P.E.P. § 2144.03 should such a position be maintained in rejection the claims of the present Application. If the Examiner relied on personal knowledge to supply the required motivation or suggestion to combine the references, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03 should such a position be maintained in rejecting the claims of the present Application. Furthermore, Applicant notes that speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.¹ and governing Federal Circuit case law.²

For at least these reasons, a *prima facie* case of obviousness cannot be maintained with respect to present Claims 1 and 15. Therefore, present Claims 1 and 15 are allowable

¹ See M.P.E.P. § 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”)

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been met motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

over *Malone* and *Riese*, whether considered alone or in combination. As such, Applicant respectfully requests reconsideration and allowance of present Claims 1 and 15, as well as all claims that depend from those claims.

Present Claims 3 and 17 are Allowable Over *Malone* in view of *Riese*

Present Claims 3 and 17 generally correspond to Claims 3 and 18 of the Parent Application at the time of the December 31, 2003 Office Action. Present Claims 3 and 17 are allowable because they depend from, and incorporate all of the limitations of, present Claims 1 and 15, respectively, which have been shown to be allowable for the reasons discussed above. Furthermore, present Claims 3 and 17 are allowable because they contain additional limitations not disclosed in *Malone* or *Riese*. For example, the Examiner alleges that *Malone* discloses drilling a central drainage well that extends downwardly from the entry well in a vertical direction. (Office Action mailed 12/31/03, page 3, ¶ 6). However, in *Malone*, main well bore 10, from which lateral wells are drilled, cannot be a *drainage* well because *Malone* discloses that well bore 10 is blocked by the insertion of the segregator body 30. FIGURES 2 and 3 of *Malone* show that the segregator body is inserted into the main well bore as a solid piece with openings 37, 38, and 39 associated with the lateral well bores. Therefore, the segregator body blocks the main well bore and provides no passages for fluids or other material to travel up the main well bore, thereby preventing the main well bore from being operable to drain the subterranean zones.

For at least this additional reason, a *prima facie* case of obviousness cannot be maintained for present Claims 3 and 17 because *Malone* and *Riese*, whether considered alone or in combination, fail to disclose each and every element of the claimed invention. Therefore, Applicant respectfully requests reconsideration and allowance of present Claims 3 and 17, as well as present Claims 4-7 and 18-21, which depend from present Claims 3 and 17, respectively.

CONCLUSION


For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully submits that Claims 1-26 of the present Application are allowable over the references cited in the December 31, 2003 Office Action for the Parent Application.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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